

## REMARKS

### Uninitialed IDS

It appears that the record for the instant case does not include an initialed copy of the Form 1449 accompanying Applicants' January 7, 2005 Information Disclosure Statement. This Information Disclosure Statement was clearly received by the Office, as it is available in PAIR. Applicants respectfully request that the Examiner consider the references listed on the Form 1449 and provide an initialed copy of the Form in the next Office Action.

### Claim Amendments

Claims 1 and 16 have been amended to recite that "the haze-prevention layer comprises at least about 50 weight percent of a metal selected from antimony, chromium, cobalt, iridium, iron, molybdenum, nickel, palladium, platinum, rhenium, rhodium, tantalum, titanium, tungsten, and vanadium". Support for these limitations may be found in claim 10 and paragraph [0044] of the application as filed.

Claim 15 has been amended to recite that the haze-prevention layer comprises "at least 50 weight percent" chromium. Support for this limitation may be found in paragraph [0044] of the application as filed. Claim 15 has also been amended to delete the tensile modulus limitation associated with the haze-prevention layer metal.

### Claim Rejection under 35 U.S.C. § 102(e) over Ohno

Claims 1, 2, 4-12, 14 and 16-18 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent No. 6,596,366 to Ohno ("Ohno"). 2/6/2006 Office Action, page 2, second paragraph. Applicants respectfully traverse this rejection to the extent it may be applicable to the claims as amended.

Ohno generally describes an optical recording medium for recording and/or retrieving information by irradiation of light. Ohno abstract. Ohno's optical recording medium comprises a substrate, an interlayer, and a reflective layer containing a metal as

the main component and a recording layer, formed in this order on the substrate directly or via another layer made of a resin or a dielectric material, wherein as observed from a light-incoming direction, the reflective layer is located in front of the interlayer, the interlayer contains the same metal as the metal constituting the main component of the reflective layer and also contains oxygen and/or nitrogen, and the interlayer has a content of the metal smaller than the reflective layer. *Id.* (Applicants respectfully note that the amorphous material described at Ohno, col. 6, lines 43-49 is part of the interlayer, not part of the substrate as suggested by the Examiner. 2/3/06 Office Action, page 2, third paragraph.)

Applicants respectfully assert that Ohno does not anticipate either of independent claims 1 and 16 because Ohno does not teach the compositional limitations of the haze-prevention layers of those claims. Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Applicants' claims 1 and 16 each recite the presence of a haze prevention layer comprising "at least 50 weight percent of a metal selected from antimony, chromium, cobalt, iridium, iron, molybdenum, nickel, palladium, platinum, rhenium, rhodium, tantalum, titanium, tungsten, and vanadium". The examiner appears to be drawing an analogy between Applicants' haze-prevention layer and Ohno's "interlayer", which is specifically referred to as a "crystal grain size-controlling layer". *See, e.g.*, Ohno, Figure 1 and col. 4, lines 38-48 and col. 5, line 38 to col. 6, line 62. Ohno's crystal grain size-controlling layer comprises the same metal as Ohno's reflective layer and further comprises oxygen and/or nitrogen. Ohno, col. 5, lines 40-42. Ohno's reflective layer comprises as its main component silver, gold, aluminum, or copper. Ohno, col. 7, lines 38-43. Ohno's reflective layer may comprise up to 5 atomic percent of impurity metals such as chromium, molybdenum, magnesium, zirconium, vanadium, indium, gallium, zinc, tin, silicon, copper, palladium, platinum, lead, tantalum, nickel, cobalt, selenium, niobium, or titanium. Ohno, col. 7, lines 51-59. Because Ohno's crystal grain size-controlling layer comprises the same metal as Ohno's reflective layer, Ohno's crystal grain size-controlling layer comprises silver, gold, aluminum, or copper as its main component and the above impurity metals at no more than 5 atomic percent. Ohno therefore does not teach Applicants' claim 1 and 16

haze-prevention layer comprising at least 50 weight percent of a metal selected from antimony, chromium, cobalt, iridium, iron, molybdenum, nickel, palladium, platinum, rhenium, rhodium, tantalum, titanium, tungsten, and vanadium. Accordingly, Ohno does not anticipate Applicants' claims 1 or 16.

Given that claims 10 and 18 have been canceled without prejudice, and given that claims 2, 4-9, 11, 12, 14, and 17 each depend ultimately from and further limit either claim 1 or claim 16, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 2, 4-9, 11, 12, 14, 16, and 17 under 35 U.S.C. § 102(e) over Ohno.

Claim Rejection under 35 U.S.C. § 103(a) over Ohno

Claim 13 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Ohno. 2/6/2006 Office Action, page 3, third paragraph. Applicants respectfully traverse this rejection to the extent it may be applicable to the claims as amended.

Applicants respectfully assert that claim 13 is patentable over Ohno because Ohno fails to teach or suggest the haze-prevention layer compositional limitations of claim 13. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g.*, MPEP 2143.03; *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). Claim 13 incorporates via dependence all the limitations of claim 1. As discussed above, Ohno fails to teach or suggest the claim 1 haze-prevention layer comprising "at least about 50 weight percent of a metal selected from antimony, chromium, cobalt, iridium, iron, molybdenum, nickel, palladium, platinum, rhenium, rhodium, tantalum, titanium, tungsten, and vanadium". Claim 13 is therefore patentable over Ohno.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 13 under 35 U.S.C. § 103(a) over Ohno.

Claim Rejection under 35 U.S.C. § 103(a) over Ohno + Narayan

Claims 3 and 15 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Ohno and further in view of U.S. Patent No. 4,937,691 to Narayan et al (“Narayan”). 2/6/2006 Office Action, page 3, last paragraph. Applicants respectfully traverse this rejection to the extent it may be applicable to the claims as amended.

Claims 3 and 15 are patentable over Ohno in view of Narayan because Ohno and Narayan collectively fail to teach the haze-prevention layer compositions of those claims. Claim 3 depends from claim 1 and therefore incorporates the limitation that the haze-prevention layer “comprises at least about 50 weight percent of a metal selected from antimony, chromium, cobalt, iridium, iron, molybdenum, nickel, palladium, platinum, rhenium, rhodium, tantalum, titanium, tungsten, and vanadium”. As discussed above, Ohno does not teach or suggest this limitation. Narayan, which does not teach an interlayer of any kind, does not remedy this deficiency. Claim 15 includes the limitation that the haze-prevention layer “comprises at least about 50 weight percent chromium”. Ohno and Narayan fail to teach or suggest this limitation. Claims 3 and 15 are therefore patentable over Ohno in view of Narayan.


Applicants therefore respectfully request the reconsideration and withdrawal of the rejection of claims 3 and 15 under 35 U.S.C. § 103(a) over Ohno in view of Narayan.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3619 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP  
Applicants' Attorneys

By:   
J. Michael Buchanan  
Registration No. 44,571

Date: April 3, 2006  
Customer No.: 23413  
Telephone: (860) 286-2929